

REMARKS

Status of the Claims

Claims 1-6, 8-23, and 25-36 are pending in the application. Claims 1, 12, 29-31, and 34-36 are amended to incorporate the limitations of originally filed claims 7 and 24. Claims 7 and 24 are cancelled. Support for the amendments can be found in originally filed claims 7 and 24, and in Table 1 on page 12 of the specification, specifically in Sample 4 of Table 1, and in the text on page 13 of the specification. No new matter is added by way of these amendments.

Rejections

Claims 1-6, 8, 10, 12-21, 25-27, and 29-35 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,942,472 to Watts ("Watts"). Claims 1-4, 6-10, 12-16, 18-19, 22-25, 27, 29-32, and 34-36 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent Publication No. 2002/0151441 to Srinivasan ("Srinivasan"). Claims 5, 8, 11, 17, 21, and 28 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Srinivasan. Claims 20 and 33 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Srinivasan in view of Watts. The rejections are wholly untenable and should be withdrawn. Reconsideration and allowance of claims 1-36 are respectfully requested in view of the following remarks.

Rejection under §102(b) in view of Watts

Claims 1-6, 8, 10, 12-21, 25-27, and 29-35 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,942,472 to Watts ("Watts"). This rejection is respectfully traversed for the following reasons.

The present claims relates to a power transmission fluid, a lubricating fluid, and methods that effectively improves the anti-shudder capability, torque performance, and/or elastomeric compatibility. The fluid contains a base oil and a transmission fluid additive composition that includes a non-dispersant viscosity index improver and is free of a dispersant viscosity index improver.

Polymethacrylate viscosity index improvers may be either of a dispersant or a non-dispersant chemical nature, depending on the composition of substituent groups in the polymer. A polymer containing polar substituents will have dispersant properties, while a polymer that is essentially non-polar will have non-dispersant properties.

In column 8, lines 30-61, Watts teaches two different methods of imparting dispersancy to viscosity index improvers ("VII"). One of skill in the art would therefore be lead toward the use of dispersant VII's, and away from the use of non-dispersant VII's, in formulations according to Watts.

Further, in Table 1, examples 1-5, the test fluid formulation of Watts includes **both** a dispersant and a non-dispersant VII, in direct contrast to the present claims excluding the presence of a dispersant VII in the fluid composition. Viscoplex 5061 is a multi-functional dispersant polymethacrylate VII, while Viscoplex 8-220 is a non-dispersant polymethacrylate VII.

Accordingly, Watts is manifestly deficient in teaching, suggesting, or disclosing a composition comprising a non-dispersant VII and excluding a dispersant VII, as in the present claims.

Further, the independent claims 1, 12, 29, 30, 31, 34, and 35 have all been amended to include the limitation of claim 7 or 24, which were not rejected in view of Watts.

Therefore, in view of these reasons, Watts fails to disclose all of the elements of the claimed invention and reconsideration and allowance of claims 1-6, 8, 10, 12-21, 25-27, and 29-35 are believed in order and are respectfully requested.

Rejection under §102(b) in view of Srinivasan

Claims 1-4, 6-10, 12-16, 18-19, 22-25, 27, 29-32, and 34-36 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent Publication No. 2002/0151441 to Srinivasan ("Srinivasan"). This rejection is respectfully traversed for at least the following reasons.

The present claims relates to a power transmission fluid, a lubricating fluid, and methods that effectively improves the anti-shudder capability, torque performance, and/or

elastomeric compatibility. The fluid contains a base oil and a transmission fluid additive composition that includes a non-dispersant viscosity index improver and is free of a dispersant viscosity index improver.

The disclosure of Srinivasan includes VII's as optional components of the fluid. (See paragraph [0080]). In paragraph [0101] Srinivasan discloses the preferred use of a dispersant polymethacrylate VII or a mixture of dispersant and non-dispersant VII's. The reference then goes on to state that "Especially preferred is an ultra high shear stable dispersant polymethacrylate viscosity index improver." Even further, in the example fluids presented by Srinivasan, the nature of the VII is not disclosed. One of skill in the art would assume that the preferred dispersant VII was used in the examples. Therefore, one of skill in the art reading Srinivasan would be led to only optionally utilize a VII, but if used, one would be led toward the use of a dispersant VII. Further one of skill in the art would not be led toward explicitly excluding a dispersant VII in favor of a non-dispersant VII, as presently claimed.

Additionally, Srinivasan does not teach, disclose, or suggest that a non-dispersant VII affects the shear stability or elastomeric compatibility of the lubricating fluid, as in the present claims. Srinivasan instead attributes such characteristics to the particular combination of mandatory components, namely, a detergent, a friction modifier, and a dispersant.

Accordingly, Srinivasan is manifestly deficient in teaching, suggesting, or disclosing a composition comprising a non-dispersant VII and excluding a dispersant VII, as in the present claims. Since Srinivasan fails to disclose all of the elements of the claimed invention, reconsideration and allowance of claims 1-4, 6-10, 12-16, 18-19, 22-25, 27, 29-32, and 34-36 are believed in order and are respectfully requested.

Rejection under §103(a) in view of Srinivasan

Claims 5, 8, 11, 17, 21, and 28 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Srinivasan. This rejection is respectfully traversed for at least the following reasons.

Claims 5, 8, 11, 17, 21, and 28 are rejected as being unpatentable over Srinivasan. As discussed above, the present independent claims are substantially distinguished over the teachings of Srinivasan. Reconsideration and allowance of dependent claims 5, 8, 11, 17, 21, and 28 are hereby respectfully requested.

Rejection under §103(a) in view of Srinivasan in combination with Watts

Claims 20 and 33 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Srinivasan in view of Watts. This rejection is respectfully traversed for at least the following reasons.

Claim 20 is dependent upon independent claim 12 and claim 33 is dependent upon independent claim 31. As set forth above both claims 12 and 31 are novel in view of either Srinivasan or Watts. Neither reference discloses, teaches, or suggests the inclusion of a non-dispersant VII and an exclusion of a dispersant VII. Therefore, their combination cannot meet the limitations of present claims 12 and 33. Reconsideration and allowance of claims 20 and 33 are hereby respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


The undersigned believes that there are no fees associated with this filing. However, if the calculations are incorrect, the Commissioner is hereby authorized to charge any deficiencies in fees or credit any overpayment associated with this communication to Deposit Account No. 12-2355. Please grant any extensions of time

required to enter this response and charge any additional required fees to Deposit
Account No. 12-2355.

Respectfully submitted,

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